

101



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,540	03/08/2001	Adrian Bot	A30571-A-PCT/USA-A	7183

7590 10/04/2004

BAKER BOTTS L.L.P.  
44TH FLOOR  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112-4498

EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/801,540

**Applicant(s)**

BOT ET AL.

**Examiner**

Joseph T. Voitach

**Art Unit**

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on March 1, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This application filed March 8, 2001 is a continuation-in-part of application 09/308,511 filed May 19, 1999, which is a 371 national stage filing of PCT/US97/21687, filed November 21, 1997, which claims priority to application 08/755,034, filed November 22, 1996, now patent 6,204,250.

Applicants amendment filed April 5, 2004, has been received and entered. The specification has been amended. Claims 1-3 have been amended. Claims 1-3 are pending and currently under examination.

### ***Specification***

The application now complies with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825.

The objection to the disclosure because the priority information must be present in the first line of the specification is withdrawn.

Amendments to the specification have obviated the objection.

### ***Priority***

The priority claim filed on April 5, 2004 was not entered because the priority claim was not filed during the required time period. For original applications filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the time period is during the

Art Unit: 1632

pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application.

In the instant case, the preliminary amendment indicated this application was only claiming benefit as a continuation in part of 09/308,511, filed May 19, 1999 (see transmittal paper with preliminary amendment filed March 8, 2001).

It is noted that if the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the

Art Unit: 1632

claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Accordingly, while the specification has been amended, the priority given the instant application is May 19, 1999 as a continuation in part of 09/308,511 as set forth in the preliminary amendment.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,204,250 is withdrawn.

The terminal disclaimer filed April 5, 2004, has obviated the rejection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn.

The amendments to the claims have addressed the basis of the rejection.

Newly amended claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, an “immunogenic composition” is now being claimed however the only structural component of the composition specifically recited is a nucleic acid. It is noted that it can encode antigens that by definition should be immunogenic, however the nucleic acid itself does not appear to be immunogenic. More clearly setting forth what is immunogenic and specific means in which it “may be used” would address the basis of the rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 1632

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3 stand rejected under 35 U.S.C. 102(b) as being anticipated by Bot *et al.*

As noted above, the instant application has been given a priority date of May 19, 1999.

As noted by Applicants' the publishing date of Bot *et al.* is December of 1996, thus still qualifies as a 102(b) type reference.

As noted previously, claims 1-3 are drawn to a method of immunizing a mammalian infant to a target antigen, by expressing one or more relevant epitopes. Bot *et al.* teach the immunization of infant mice comprising the administration of recombinant nucleic acid encoding the NP peptide, and demonstrated a decrease viral titer in an infant mouse following challenge with influenza virus (see entire article). Bot *et al.* teach both the nucleic acid product and the method of use for immunizing.

Thus, the claimed invention is anticipated, and the rejection is maintained.

Claim 3 stands rejected under 35 U.S.C. 102(b) as being anticipated by Lai *et al.*

Claim 3 stands rejected under 35 U.S.C. 102(b) as being anticipated by Assateerawatt *et al.* (1993).

Claim 3 stands rejected under 35 U.S.C. 102(b) as being anticipated by del Canho *et al.*

Applicants argue that by Lai *et al.*, Assateerawatt *et al.* (1993) and del Canho *et al.* each teach methods of vaccination wherein a recombinant protein is administered, not the DNA used to make the recombinant protein. Applicants arguments have been fully considered and found

Art Unit: 1632

persuasive for method claims 1 and 2. After review of the references Examiner acknowledges that while recombinant technology was used to generate the vaccines, the polynucleotides were not administered to the subject. However, as acknowledged in Applicants' arguments, the references do teach a recombinant polynucleotide capable of encoding the antigens.. Since each Lai *et al.*, Assateerawatt *et al.* (1993) and del Canho *et al.* teach the use of recombinant proteins made of recombinant DNA technology, the vectors "***may be used*** in a method of inducing a cellular immune response" (***emphasis added*** claim 3) as evidenced by the cited references. In this case it was used to generate the protein used in the vaccine.

### ***Conclusion***

No claim is allowed. DNA vaccines were known at the time of filing (see for example Donnelly *et al.* 1994 (IDS reference)), and experiments demonstrated that nucleic acids encoding antigens could be administered as vaccines (see Donnelly *et al.* figure 1 for example (IDS reference)). However, while the technique was demonstrated to be affective in adults, what was not demonstrated was that the technique could be extended to infants.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on



Art Unit: 1632

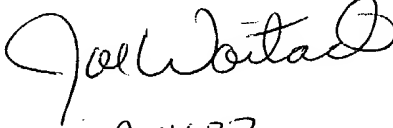
the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (571) 272-0734.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach

  
AU1632